



# UNITED STATES PATENT AND TRADEMARK OFFICE

## Patent Tips for Success



**USPTO-MBDA Webinar Series**

December 9, 2014

# Agenda

- Introduction
- 10 Patent Tips for Success
- Facilitated question and answer session

## Patent Tip 1: Recognize and Understand the Different Forms of IP

- Different types of intellectual property are protected by different means
- Multiple forms of IP protection may be valuable and/or necessary in a business enterprise
- Try: **IP Awareness Assessment Tool**
  - <http://www.uspto.gov/inventors/assessment/index.html>

# Intellectual Property

	<u>Utility Patent</u>	<u>Design Patent</u>	<u>Trade Secrets</u>	<u>Copyrights</u>	<u>Trademarks</u>
<b>What is protected</b>	Inventions -Process, machine, manufacture, or composition of matter	Ornamental characteristics embodied in, or applied to, an article of manufacture	Business related information (formulas, techniques, information)	Art, in an all encompassing sense	Marks that indicates the source or origin of goods or services
<b>Requirements</b>	Utility, novelty, and non-obviousness	Novelty and non-obviousness	Commercial value, generally not known, and reasonable efforts of secrecy	Original, authorship, and fixation in a tangible medium	Use in commerce and either distinctiveness or secondary meaning
<b>Protects Against ...</b>	Making, selling, offering for sale, and importing	Making, selling, offering for sale, and importing	Stealing	Copies, performances, displays, and derivative works	Use of a mark that causes the likelihood of confusion
<b>Endures until ...</b>	20 years from filing date	14 years* from issuance	Public Disclosure	The life of the author +70 years	Abandoned
<b>Rights of Independent Creators</b>	None	None	Full	Full	None

# IP Awareness Assessment Tool

A business and inventors IP evaluation tool

## IP Awareness Assessment

The IP Awareness Assessment, developed under the joint efforts of United States Patent and Trademark Office (USPTO) and National Institute of Standards and Technology/Manufacturing Extension Partnership (NIST/MEP), allows you to assess your intellectual property awareness. Following the completion of the assessment, you will receive a customized training material. [Learn more](#)

## Feedback

Your **feedback** and comments are crucial for improving the IP Awareness Assessment.

## Inventor Assistance Program

## Important Notice

Please note that any information provided here does not constitute legal advice, but is intended to increase your IP awareness. When filing an application for obtaining specific IP rights, it is recommended that you obtain professional legal assistance. The IP Awareness Assessment contains links to external websites. USPTO does not maintain those external sites and is not responsible for the material found therein.

Welcome to the Intellectual Property Awareness Assessment Tool. The IP Assessment includes the below five general categories, that are included in all assessments.

- IP Strategies & Best Practices
- International IP Rights
- IP Asset Tracking
- Licensing Technology to Others
- Using Technology of Others

There are five additional categories that all can take or, which may be customized through a Pre-assessment. These five categories include:

- Copyrights
- Design Patents
- Trademarks
- Trade Secrets
- Utility Patents

Not all businesses have all categories of IP Assets so they have an opportunity to opt out of certain categories by using the customizer or Pre-assessment or may opt to take the full assessment of ten categories containing 62 questions.

The full assessment requires about 20-30 minutes to complete. The customizer or Pre-assessment can reduce the required time by 10-15 minutes.

» enter the IP Awareness Assessment

Before starting the assessment, please note:

- Save the link for this page as a favorite/bookmark on your browser.
- In the "Internet Options" of your browser, deselect/uncheck history on exit. This will allow you to return and resume your assessment session in case you cannot finish it in one sitting. This will also allow you to access your training materials and assessment results at your convenience.
- As you are answering the assessment questions, choose the answer that best applies to your business or circumstances as an independent inventor or individual. Where applicable, choose all the responses that apply to your situation.
- Responses or data collected in the assessment are not stored or used by the USPTO or NIST MEP.

## Patent Tip 2: If Seeking a Patent, Know What Type of Patent is Right for You

- What is the nature of your invention, or what is it you are trying to protect?
- Keep in mind, oftentimes more than one type of patent may be useful or necessary

- Utility

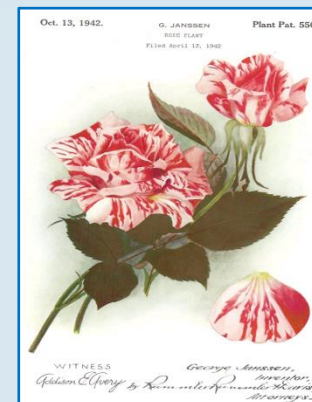
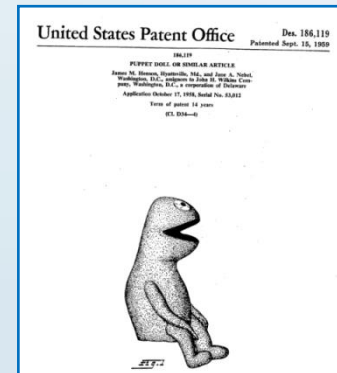
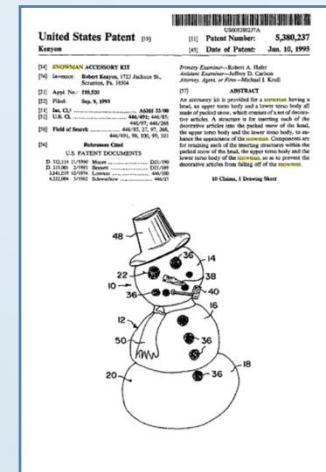
New and useful process, machine, article of manufacture, or composition of matter, or any new and useful improvement thereof

- Design

## Any new, original and ornamental design

- Plant

Whoever invents or discovers and asexually produces any distinct and new variety of plant



## Patent Tip 3: Know the Difference Between a Provisional and Non-Provisional Patent Application

- **Provisional** - one year period, no claims required, written disclosure must meet same requirements as non-provisional, not allowed for design.
- **Non-Provisional** - claims required, written disclosure must meet requirements of 35 USC 112 1st paragraph. Examined for patentability, can result in a patent.

## **Patent Tip 4:** Conduct a Thorough Prior Art Search

### **What Documents are Available to be Searched?**

- **US Patents and US Published Applications**
- **Foreign Patent Documents  
(e.g., EPO and JPO)**
- **Non-Patent Literature (any published documents  
publicly available other than Patents or Published  
Patent Applications)**
  - Internet Searches (Google, Yahoo, etc.)
  - Trade Publications and Databases (e.g., IEEE, CHEMnetBASE,  
MechanicalEngineeringnetBASE)

# What Searching Provides for You

- **New ideas**
- **Improvements to your invention**
- **History of technological advances**
- **Trends and developments in field**
- **To see if any Prior Art related to your invention exists**
- **Helps determine if you want to file an application**

# What Searching Provides for You

- **Familiarize yourself with patent documents & process**
- **Better prepared to discuss with attorney**
- **Helps to determine the appropriate claim scope when drafting claims**
- **Avoid duplicating R&D efforts**
- **Identify competitors/experts/investors in the field**

## Patent Tip 5: Recognize and Provide the Proper Parts, Form and Content When Filing a Patent Application

- Study relevant patents in your technological field – use as a guide
- Patent Specification: Use appropriate headings and sections
  - Provide necessary specificity
- Patent Claims
- Use USPTO forms available at:  
<http://www.uspto.gov/forms/index.jsp>
- <http://www.uspto.gov/inventors/prose.jsp>

# Parts, Form and Content

## Arrangement of Application

- Title
- Cross-Reference to Related Applications
- Statement Regarding Federally Sponsored Research or Development
- Background of the Invention
- Brief Summary of the Invention
- Brief Description of the Drawings
- Detailed Description of the Invention
- Claims
- Abstract
- Drawings
- Sequence or Computer Program Listings

# Parts, Form and Content

## Claims

- Must commence on a separate sheet
- Must particularly point out and distinctly claim the subject matter which applicant regards as his/her invention or discovery
- Must conform to the invention as set forth in the remained or the specification – there must be antecedence of the terms and phrases found in the written description for the claims
- The claims shall be numbered consecutively in Arabic numerals
- The original numbering of the claims must be preserved throughout the prosecution of the application – when claims are cancelled the remaining claims must not be renumbered

## Patent Tip 6: Timely Pay Correct Fees

- Question: Are you a large, small or micro-entity filer?
- Regularly visit: Current Fee Schedule (as fees may change)
- Surcharges incurred with delays or insufficiencies
- Note: Non-electronic filing fee

# Micro Entity

Applicant must certify that applicant:

- Qualifies as a small entity
- **Previous application limit:** Has not been named as an inventor on more than 4 previously filed applications
- **Gross income threshold:** Did not have a gross income exceeding 3 times the median household income in the preceding calendar year, and
- **Assignment:** Did not convey a license or other ownership interest in the application to an entity that had a gross income exceeding 3 times the median household income in the preceding calendar year

# Micro Entity Form

Document Description: Certification of Micro Entity Status (Gross Income Basis)

PTO/SB/15A (03-13)

## CERTIFICATION OF MICRO ENTITY STATUS (GROSS INCOME BASIS)

Application Number or Control Number (if applicable):

Patent Number (if applicable):

First Named Inventor:

Jane Doe

Title of Invention:

Dough Making Machine

The applicant hereby certifies the following—

- (1) **SMALL ENTITY REQUIREMENT** - The applicant qualifies as a small entity as defined in 37 CFR 1.27.
- (2) **APPLICATION FILING LIMIT** - Neither the applicant nor the inventor nor a joint inventor has been named as the inventor or a joint inventor on more than four previously filed U.S. patent applications, excluding provisional applications and international applications under the Patent Cooperation Treaty (PCT) for which the basic national fee under 37 CFR 1.492(a) was not paid, and also excluding patent applications for which the applicant has assigned all ownership rights or is obligated to assign all ownership rights as a result of the applicant's previous employment.

# Micro Entity Form

- (3) **GROSS INCOME LIMIT ON APPLICANTS AND INVENTORS** - Neither the applicant nor the inventor nor a joint inventor, in the calendar year preceding the calendar year in which the applicable fee is being paid, had a gross income, as defined in section 61(a) of the Internal Revenue Code of 1986 (26 U.S.C. 61(a)), exceeding the "Maximum Qualifying Gross Income" reported on the USPTO website at [http://www.uspto.gov/patents/law/micro\\_entity.jsp](http://www.uspto.gov/patents/law/micro_entity.jsp) which is equal to three times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census.
- (4) **GROSS INCOME LIMIT ON PARTIES WITH AN "OWNERSHIP INTEREST"** - Neither the applicant nor the inventor nor a joint inventor has assigned, granted, or conveyed, nor is under an obligation by contract or law to assign, grant, or convey, a license or other ownership interest in the application concerned to an entity that, in the calendar year preceding the calendar year in which the applicable fee is being paid, had a gross income, as defined in section 61(a) of the Internal Revenue Code of 1986, exceeding the "Maximum Qualifying Gross Income" reported on the USPTO website at [http://www.uspto.gov/patents/law/micro\\_entity.jsp](http://www.uspto.gov/patents/law/micro_entity.jsp) which is equal to three times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census.

## SIGNATURE by a party set forth in 37 CFR 1.33(b)

Signature	/jane doe/			
Name	Jane Doe			
Date	1/1/01	Telephone	555-555-5555	Registration No.

## Patent Tip 7: Respond Thoroughly and Timely to All Communications

- Respond in writing to all objections and rejections set forth by examiner
- Present arguments as appropriate
- Consider requesting an examiner interview
  - Telephonic, in-person
  - Ask for help and/or clarification

## Patent Tip 8: Consider Using a Patent Attorney or Patent Agent

- View USPTO listing of registered attorneys and agents
- Law School Clinical Programs and pro bono assistance available in some areas
  - <http://www.uspto.gov/inventors/proseprobono/index.jsp>

# Pro Bono Requirements

- Determined by regional programs
- Income < 300% of federal poverty level
  - Depends on location and household size
- Knowledge of the patent system
  - Pending application
  - Completion of [Certificate Training Course](#)
- Possession of an actual invention
  - Not just an idea

# Certificate Training Course



UNITED STATES PATENT AND TRADEMARK OFFICE

## Basic Patent Training For Independent Inventors and Small Businesses

A full transcript can be found under the “Notes” tab

certification package  
**John Calvert**  
Administrator - Inventor Assistance Program

Outline	Thumb	Notes	Search
Slide Title	Duration		
▶ 1. Introduction/Access...	00:23		
2. Constitutional Power	00:29		
3. I have an Idea!	01:14		
4. File Provisional App...	01:56		
5. Requirements?	01:02		
6. Questions	00:05		
7. Provisional Pitfalls	01:08		
8. Provisionals: What ...	00:36		
9. Dates of Provisional	00:31		
10. Dates of Provisional	01:01		
11. Dates of Provisional	00:38		
12. Non-provisional a...	01:60		
13. Non-provisional a...	00:52		
14. Design Application?	01:23		
15. Foreign Filing?	01:06		
16. Application Prosec...	01:22		
17. Examination	01:56		
18. Office Action	01:25		
19. Claims and Amen...	01:42		
20. Response to Offic...	02:11		
21. Applicant Response	01:07		
22. Appeals	01:46		
23. Advanced Prosecu...	01:43		

39 Minutes 13 Seconds Remaining

Slide 1 / 30 | Stopped

00:00 / 00:23

# Pro Bono Assistance

- By the end of 2014, we anticipate at least part or all of 47 states to have a program
  - Including Michigan
- Online clearinghouse to connect inventors to regional pro bono programs
  - <http://www.fedcirbar.org/ptoprobono>
- Operated by the Federal Circuit Bar Association




## Patent Tip 9: Avoid Getting Scammed

- Always check the reputation of invention promoters/promotions firms before making any commitments
  - View published complaints
  - Request required information disclosures
- Be cautious of non-USPTO solicitations

# Patent Tip 10: For Resources and Tools Visit USPTO on the Web

## www.USPTO.gov

**uspto.GOV**


search for patents | search for trademarks  
Search our site 


The United States Patent and Trademark Office  
an agency of the Department of Commerce

PATENTS | TRADEMARKS | IP LAW & POLICY | PRODUCTS & SERVICES | INVENTORS | NEWS & NOTICES | FAQs | KIDS | ABOUT US

**MBDA and USPTO Host Webinar Series for Business Owners**

The Minority Business Development Agency (MBDA) and the USPTO will conduct a free three-part webinar series August 12-14 to help business owners understand the intellectual property process.

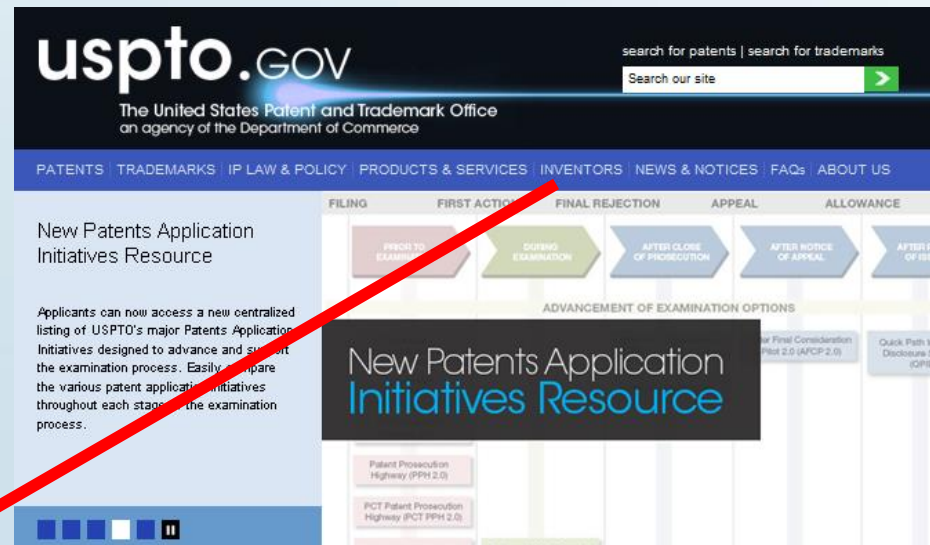




# Features of the Website

- Apply Online for a Patent using EFS-Web
- Obtain Status of a Patent Application
- Determine when application will be picked up for examination, see First Office Action Estimator
- Search US Patent Database
- Search Patent Classification Manual
- Download Forms and Fee Schedules
- Patent Helpful Resources
- Access Details of All Currently Pending Published Patent Applications (Public PAIR)
- **IP Awareness Assessment Tool**

# Overview of Website



Click on  
“Inventors”

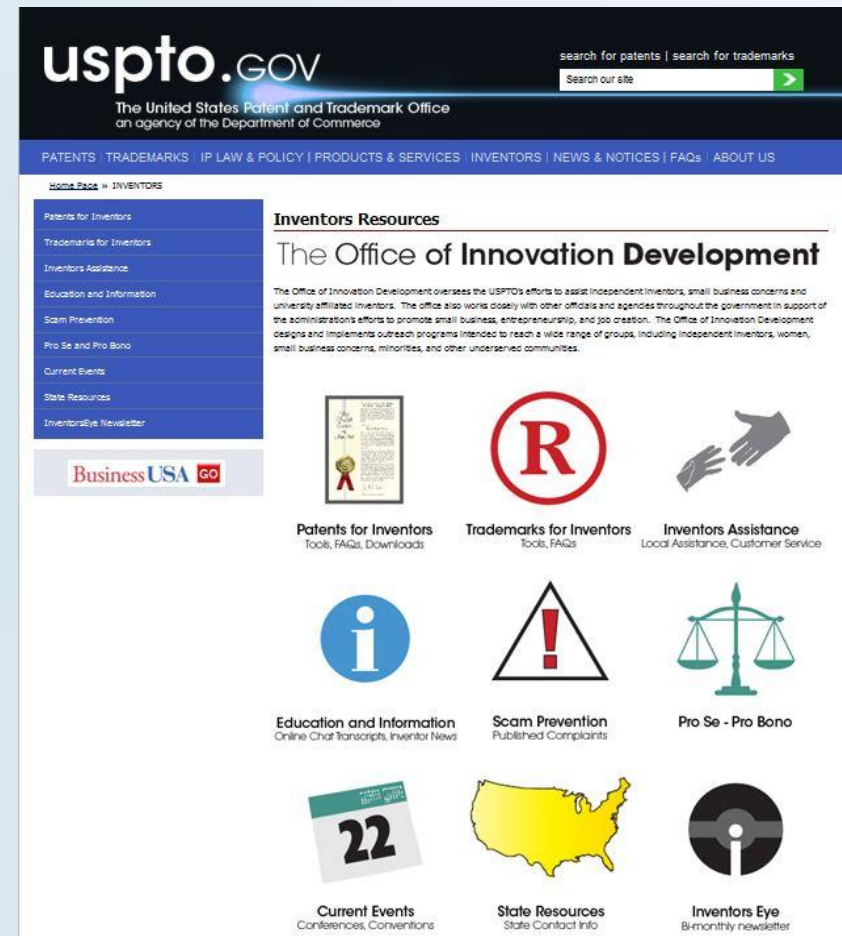


Helpful links for independent inventors

- General Information
- Introductory Guides
  - FAQs
- Upcoming Events
- Registered Attorneys & Complaints Against
  - Inventors Assistance Center
  - and much more...

# Inventor Resources

- Wide variety of resources to help the independent inventor
- [www.uspto.gov/inventors](http://www.uspto.gov/inventors)



The screenshot displays the 'uspto.GOV' website, specifically the 'Inventors Resources' section. The header includes the USPTO logo and navigation links for Patents, Trademarks, IP Law & Policy, Products & Services, Inventors, News & Notices, FAQs, and About US. A search bar is located in the top right corner. The main content area is titled 'Inventors Resources' and 'The Office of Innovation Development'. It provides a brief description of the office's mission to assist independent inventors, small business concerns, and university-affiliated inventors. Below this, there are nine icons representing different resources: Patents for Inventors (Tools, FAQs, Downloads), Trademarks for Inventors (Tools, FAQs), Inventors Assistance (Local Assistance, Customer Service), Education and Information (Online Chat Transcripts, Inventor News), Scam Prevention (Published Complaints), Pro Se - Pro Bono, Current Events (Conferences, Conventions), State Resources (State Contact Info), and Inventors Eye (Bi-monthly newsletter).

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an agency of the Department of Commerce

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Search our site

PATENTS | TRADEMARKS | IP LAW & POLICY | PRODUCTS & SERVICES | INVENTORS | NEWS & NOTICES | FAQs | ABOUT US

Home Page » INVENTORS

**Inventors Resources**  
**The Office of Innovation Development**

The Office of Innovation Development oversees the USPTO's efforts to assist independent inventors, small business concerns and university-affiliated inventors. The office also works closely with other officials and agencies throughout the government in support of the administration's efforts to promote small business, entrepreneurship, and job creation. The Office of Innovation Development designs and implements outreach programs intended to reach a wide range of groups, including independent inventors, women, small business concerns, minorities, and other underserved communities.

**Patents for Inventors**  
Tools, FAQs, Downloads

**Trademarks for Inventors**  
Tools, FAQs

**Inventors Assistance**  
Local Assistance, Customer Service

**Education and Information**  
Online Chat Transcripts, Inventor News

**Scam Prevention**  
Published Complaints

**Pro Se - Pro Bono**

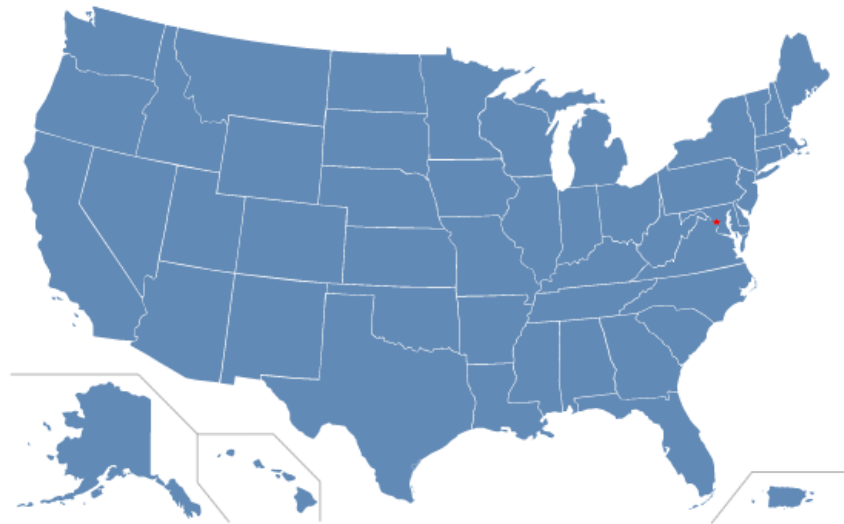
**Current Events**  
Conferences, Conventions

**State Resources**  
State Contact Info

**Inventors Eye**  
Bi-monthly newsletter

# State Resources - Select Your State

## UNITED STATES MAP



This map derived from [commons.wikimedia.org](https://commons.wikimedia.org)

### List of State Names

<a href="#">Alabama</a>	<a href="#">Georgia</a>	<a href="#">Maryland</a>	<a href="#">New Jersey</a>	<a href="#">Rhode Island</a>	<a href="#">Wisconsin</a>
<a href="#">Alaska</a>	<a href="#">Hawaii</a>	<a href="#">Massachusetts</a>	<a href="#">New Mexico</a>	<a href="#">South Carolina</a>	<a href="#">Wyoming</a>
<a href="#">Arizona</a>	<a href="#">Idaho</a>	<a href="#">Michigan</a>	<a href="#">New York</a>	<a href="#">South Dakota</a>	
<a href="#">Arkansas</a>	<a href="#">Illinois</a>	<a href="#">Minnesota</a>	<a href="#">North Carolina</a>	<a href="#">Tennessee</a>	
<a href="#">California</a>	<a href="#">Indiana</a>	<a href="#">Mississippi</a>	<a href="#">North Dakota</a>	<a href="#">Texas</a>	
<a href="#">Colorado</a>	<a href="#">Iowa</a>	<a href="#">Missouri</a>	<a href="#">Ohio</a>	<a href="#">Utah</a>	
<a href="#">Connecticut</a>	<a href="#">Kansas</a>	<a href="#">Montana</a>	<a href="#">Oklahoma</a>	<a href="#">Vermont</a>	
<a href="#">Delaware</a>	<a href="#">Kentucky</a>	<a href="#">Nebraska</a>	<a href="#">Oregon</a>	<a href="#">Virginia</a>	
<a href="#">District of Columbia</a>	<a href="#">Louisiana</a>	<a href="#">Nevada</a>	<a href="#">Pennsylvania</a>	<a href="#">Washington</a>	
<a href="#">Florida</a>	<a href="#">Maine</a>	<a href="#">New Hampshire</a>	<a href="#">Puerto Rico</a>	<a href="#">West Virginia</a>	



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# Thank You!



[www.uspto.gov](http://www.uspto.gov)